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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,248	02/02/2001	B. J. Hawkins	2073.301	8158

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FULBRIGHT AND JAWORSKI L L P
PATENT DOCKETING 29TH FLOOR
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EXAMINER

KYLE, CHARLES R

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/776,248	Applicant(s) HAWKINS, B. J.	
	Examiner Charles R Kyle	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/08/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner's Note

In accordance with a telephone conversation with John May on December 21, 2004, Applicant elects Claims 1-29 with traverse. Renumbered Claim 30 (formerly 29) is withdrawn.

Claim Objections

Claims 12-24 are objected to because of the following informalities: They recite at step d), the phrase “allowing prospective suppliers to *access view* the requisition on line”, which is redundant. Appropriate correction is required.

Claim 17 recites “authorized supplier”; it appears that “suppliers” is intended

Claim 20 recites steps a) - d); this sequence of step identifiers is already recited in Claim 12.

Claim 21 recites steps e) - g); this sequence of step identifiers is already recited in Claim 12.

Claim 22 recites steps a) - b); this sequence of step identifiers is already recited in Claim 12.

Claims after Claim 26 are misnumbered. Two Claims numbered 26 are presented. The second Claim 26 is renumbered as 27 and its successors are renumbered from 27-29 to 28-30.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At step b) of Claim 113, “registrating” is recited; this is not a word. Also at step b), “other information deemed relevant by the organization” is recited. One of ordinary skill in the trading arts would not know what constitutes “relevance.”

Claims 7 and 22 recite a step a) of “time period during which...” A time period cannot be a method step.

The Claims have been examined to the best of the Examiner’s ability given the condition of the Claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 10-22, 25-26 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,758,328 *Giovannoli* in view of US 6,161,099 *Harrington*.

With respect to Claim 1, see the discussion of Claims 12 and 13. *Giovannoli* further discloses that suppliers indicate areas of interest at Col. 5, lines 9-36 and a detailed copy of a requisition at Fig. 7.

With respect to Claims 2-5, see the discussion of Claim 1 and Claims 16; 18, 19 and 20 respectively.

With respect to Claims 6-7, see the discussion of Claim 1 and Claims 21 and 22 respectively.

With respect to Claims 10-11, see the discussion of Claim 1 and Claims 14 and 15 respectively.

With respect to Claim 12, *Giovannoli* discloses the invention substantially as claimed, including in a method for an organization to conduct a bidding process for products or services it needs on a computer system over the internet comprising the steps of:

- a) creating a requisition for purchase of sundry items or services needed (Col.5, lines 3-8);
- b) posting the requisition for purchase on an electronic site accessible over an internet wherein the requisition is accessible by third parties over the internet (Col. 5, lines 6-8 and lines 37-51);
- c) notifying by electronic mail prospective suppliers of the services or products requested in the requisition, of the existence of the pending requisition (Col. 4, lines 46-49, Col. 6, lines 2-7); Fig. 2A, fourth box),

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d) allowing prospective suppliers to access view the requisition on line (Col. 5, lines 37-51; Col. 7, lines 3-47);

e) accepting from prospective suppliers electronic bids for supplying the product or service sought by the requisition (Col. 9, lines 14-20);

Giovannoli does not specifically disclose closing of the bidding process and award of the requisition to a supplier. *Harrington* discloses these limitations at Col. 2, lines 20-25 and Col. 4, lines 10-17 respectively, at least. Further, the ending of an auction at a specific time and selection of a winner is old and well known in the trading arts. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Giovannoli* with the limitations disclosed by *Harrington* and known in the trading arts because this would logically finish the object of bidding process, to complete a contract so as to actually obtain goods or services.

With respect to Claim 13, *Giovannoli* further discloses supplier registration at Fig. 3 and Col. 4, lines 1-4; contact information at Fig. 8; supplier compliance with predefined criteria and supplier approval to submit bids at Col. 5, line 9 to Col. 6, line 11. Further, *Harrington* discloses bidder approval at Figs 7 and 8.

With respect to Claims 14 and 15, Official Notice is taken that it was old and well known to exchange commercial questions and answers over the Internet at the time of the invention. For example, online negotiation regarding transaction details was frequently done. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify

Giovannoli to include such exchanges because this would provide a familiar an inexpensive communications conduit.

With respect to Claim 16, *Giovannoli* does not specifically disclose a sealed bid process. *Harrington* discloses this limitation at Background of the Invention in several instances. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Giovannoli* with the sealed bid process of *Harrington* because this would provide expeditious bid processing.

With respect to Claim 17, *Giovannoli* discloses notifying only authorized suppliers in that only suppliers meeting filter conditions are selected to receive RFQs. See *Giovannoli* at Col. 5, lines 9-36.

With respect to Claim 18, Official Notice is taken that it was old and well known to alternatively provide awards in single or multiple element groups. For example, if a single supplier if *Giovannoli* were unable to meet total buyer requirements (e.g., vendor ACME Resistor Supply, Inc. of Fig. 8 could supply only 5,000 resistors when the potential buyer needed 50,000) a split of the requirements into several units would be necessary. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Giovannoli* to provide such splitting to meet potential buyer needs.

With respect to Claim 19, *Giovannoli* further discloses:

- f) identifying the product or service needed (Fig. 9, "Product Identification")
- g) itemizing in a line by line fashion particulars of each item being sought by the requisition (Fig. 7, "Sample Buyer's Data Packet");
- h) providing bidding instructions (Fig. 7, "Note");

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j) setting a date by which the items being bid on must be supplied by a supplier awarded the requisition ("Delivery Date", Col. 5, lines 49-54).

As to the limitation reciting assigning a closing date, discussed in Claim 12, such assignment is inherent to the closing itself.

Concerning Claim 20, *Giovannoli* further discloses:

- a) allowing accesses by a prospective supplier to a database with requisitions posted at the accessible site (Fig. 2A, Fourth box; Summary of the Invention);
- b) selecting by the prospective supplier a requisition to enter a bid on (Co. 5, lines 37-54);
- c) and d) making by the prospective supplier an offer to supply a service or product listed in the requisition at a specific price, and providing by the prospective supplier particular information regarding the service or product the prospective supplier proposes to provide to fulfill an award of the bid (Fig. 8).

Regarding Claim 21, *Giovannoli* further discloses:

- f) reviewing the bids made by various prospective suppliers (Col. 7, line 53 to Col. 8, line 57); and
- g) selecting from the bids offered one to which the requisition will be granted based on the organizations selection criteria (Col. 9, line 13-19).

As to the limitation reciting closing the requisition, see the discussion of Claim 12.

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As to Claim 22, steps b) and c) are disclosed by *Harrington* as a closing time of the auctions, by which all bids need be submitted and bids cannot be altered or withdrawn.

With respect to Claim 25, *Giovannoli* also discloses a computer (Vol. 6, lines 36-59) of an organization connected to the Internet (Fig. 1) having an interactive memory (Vol. 6, lines 36-59). *Giovannoli* further discloses that a third party obtains access to requisitions in an interactive memory at Figs. 2A and 2B. A bid protocol is disclosed as the method discussed in Claims 1 and 12, at least.

Concerning Claim 26, Official Notice is taken that the classifications of individuals recited was old and well known at the time of the invention. For example, the various titles recited are those of a traditional purchasing department having proper internal control. The Examiner makes this observation having been employed as an accountant for nine years. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Giovannoli* to include these functions to provide proper accounting controls for purchases.

With respect to Claim 28, see the discussion of Claim 26 with respect to purchasing functions. Likewise, the recited requisition states are old and well known and would modify *Giovannoli* to provide logical and accountable purchasing functions.

With respect to Claim 29, *Giovannoli* discloses the use of a website at Col. 4, lines 50-60, at least

Claims 8-9, 23-24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,758,328 *Giovannoli* in view of US 6,161,099 *Harrington* and further in view of US 6,629,082 *Hambrecht et al.*

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With respect to Claims 8-9, see the discussion of Claim 1 and Claims 22-23.

With respect to Claims 23 and 24, *Giovannoli* discloses the invention substantially as claimed. See the discussion of Claim 12 above. *Giovannoli* does not specifically disclose saving locked auction data for audit purposes. *Hambrecht* discloses this limitation at Col. 8, line 52 to Col. 9, lines 35-47 and Col. 11, lines 8-10 at least. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Giovannoli* to include these limitations because this would provide a method to review auction results for accuracy and fairness. Further, the locking format recited is the equivalent of a "Read Only" file, which was old and well known and prevents tampering with important information, such as auction audit data.

As to Claim 27, see the discussion of Claims 25 and 23.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kyle whose telephone number is ^{571 272 6746}~~(703) 305-4458~~. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on ^{571 272 6747}~~(703) 308-1065~~. The fax phone number for the organization where this application or proceeding is assigned is ^{unavailable at this time.}~~703-872-9306~~.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

crk
December 23, 2004

Examiner Charles Kyle

A handwritten signature in black ink, appearing to read "Charles Kyle", with a stylized flourish at the end.